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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,468	10/23/2001	Roger A. de la Torre	SPC-5068CNT6	6548

27777 7590 04/06/2004  
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NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 04/06/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/004,468

Applicant(s)

DE LA TORRE ET AL.

Examiner

Glenn K Dawson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34,35,37,38 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34,35,37,38,40-48 and 50-53 is/are rejected.
- 7) ☒ Claim(s) 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____  |

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***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34,35,40,42-48,50 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-28 of U.S. Patent No. 6319246. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are broader in scope than those of the patent in some respects, or use slightly different language to claim to same elements. For example, claim 28 of the patent claims the members are flexible and can be clamped closed to seal access to the passageway. One therefore can infer from this that the members have a sealable opening. and if it is sealable, it can therefore seal around either something placed through it (i.e. an arm) or sealed without anything through it. It also would have been obvious to make the seal without something going through it to maintain insufflation gas pressure in the body cavity during instrument exchange or withdrawal.

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Claims 37,41 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-28 of U.S. Patent No. -'246 in view of Cuschieri, et al.-5480410.

The patent claims the invention of the application as claimed with the exception of the tongue and groove seals, and a 2<sup>nd</sup> sealable opening. Cuschieri discloses a plurality of sealable openings on a laparoscopic port; the seals can be tongue and groove seals (see col. 4 line 61-col. 5 line 3.). It would have been obvious to employ the use of a plurality of tongue and groove seals on the access port of the -'246 patent, as it has been shown that these were obvious alternative seals which for laparoscopic ports for facilitating the passage of instruments therethrough and a plurality of them allows for simultaneous introduction of various instrument into the surgical field for performing various operations in the operative field.

Claims 38 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-28 of U.S. Patent No. 6319246 in view of Leyva-5522791.

The patent claims the invention of the application as claimed with the exception of the flexible cord for sealing the opening. Leyva discloses a flexible cord 42 for closing a sealable opening 34 of a laparoscopic port. It would have been obvious to have provided the -'246 patent access port with a cord for sealing the opening, as simply an obvious alternative sealing means which would be easy to manufacture and use.

***Allowable Subject Matter***

Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Glenn K Dawson  
Primary Examiner  
Art Unit 3761

Gkd  
04 April 2004